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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,048	04/06/2001	Ilan Golecki	050-96-018	5765
128	7590	04/20/2004	EXAMINER	
HONEYWELL INTERNATIONAL INC. 101 COLUMBIA ROAD P O BOX 2245 MORRISTOWN, NJ 07962-2245			BRUNSMAN, DAVID M	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/828,048

Applicant(s)

GOLECKI, IAN

Examiner

David M Brunzman

Art Unit

1755

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

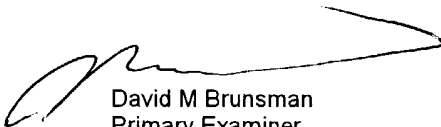
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1,5,10,11,13 and 22-27.Claim(s) withdrawn from consideration: 2-4 and 6-9.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: see attachment

  
David M Brunzman  
Primary Examiner  
Art Unit: 1755

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Applicants' response filed 09 April 2004 has been carefully considered. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP 821.01. Applicants, apparently inadvertent, oversight in complying with the requirement will not be waived in any further response. Any further communication in this application will be held non-responsive if appropriate action under rule 144 is omitted.

Applicants have elected to prosecute inventions wherein the "material" is "a compound of silicon, oxygen, and carbon". The examination remains subject to that election.

Claims 1, 5, 10, 11, 13 and 22-27 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4737379.

The instant claims are drawn to coatings (construed as a deposited film) comprising compounds of silicon, oxygen and carbon (silicon oxycarbide). The recitation of the substrate such as a carbon-carbon composite or a plate fin heat exchanger does not materially limit a claim to the film itself. Such recitation is an indication of the intended use of the film. Patentability does not depend upon intended use. *Ex Parte Wikdahl*, 10 USPQ2d 1546. There is no evidence of record of an actual material difference between the films of the reference and those of the instant claims. Claim 11 requires that the coating of claim 1 is graded through its thickness. Page 6, line 19 through page 7, line 12; of the specification defines "graded" as having a composition that varies in a continuous or step manner through its thickness.

US Patent 4737379 teaches films comprising  $\text{SiC}_x\text{O}_y$  wherein x and y are from 0 to 2, where  $x/2 + y/2$  approaches 1. Column 16, lines 65+ teach that such layer preferably may be deposited upon an underlayer of a composition differing from the main layer in hydrogen content which underlayer is applied directly to the surface of the substrate (See column 16, lines 39-45). That deposition forms a multilayer film having a composition that varies in a step manner through the thickness of the film. The carbon of said  $\text{SiC}_x\text{O}_y$  is chemically bound in the compound as described in the same manner in the prior art document that is relied upon by applicant as antecedent basis for newly added claim 25 in the instant specification as originally filed.